

IN THE U. S. PATENT AND TRADEMARK OFFICE

In re application of

Enok TJOTTA

Conf. 5328

Application No. 10/530,488

Group 1642

Filed April 6, 2005

Examiner Peter J Reddig

METHOD FOR SELECTION OF COMPOUNDS WHICH INHIBIT CLONAL
CELL GROWTH AND USE THEREOF

Petition to the Director Under 37 CFR §1.181

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

March 17, 2009

Sir:

The Director is hereby petitioned to withdraw the
holding of finality in the Office Action of September 17, 2008.

Statement of Facts

The application was filed on April 6, 2005.

On September 11, 2007 an Office Action was mailed which
rejected pending claim 13-27 under 335 USC §112, second paragraph
as being indefinite. An attached Interview Summary asserted that
proper search and examination of the present invention should be
based on amended claims.

On January 11, 2008, an Amendment was filed by the
Applicant which canceled the pending claims and presented claims
28-61 for prosecution on the merits.

On May 8, 2008 an Election/Restriction Requirement was mailed which cited the references of VERMA et al. (Cancer Research) and WO 01/00585 in relation to issues of general inventive concepts under PDT rules 13.1 and 13.2.

On June 9, 2008 a Response to the Election/Restriction Requirement was filed by the Applicant.

On September 17, 2008 an Office Action was mailed which objected to the drawings, rejected claims under 335 USC §112, second paragraph, rejected claims under 35 USC §112, first paragraph, rejected claims under 35 USC §102(b) as being anticipated by PRECHEL et al. (Cancer Letters) as evidenced by CAR et al. (Toxicological Pathology), rejected a claim under 35 USC §103(a) as being unpatentable over PRECHEL et al., DE ASUA et al. (Proc. Natl. Acad. Sci.) and KAMEI (Cell Biol. Int. Rep.) and rejected a claim under PRECHEL et al. in view of TAMI et al. (USP 4,744,985). This Office Action was made final.

On December 17, 2008, an Amendment was filed by the Applicant which amended claims, presented remarks and presented an amended drawing figure.

On March 12, 2009 (5 days before the end of the 6 month statutory period) an Advisory Action was mailed. This Advisory Action contained more than four and one half pages of commentary supporting the Examiner's position.

Remarks

As is clear from the history outlined above, there was no substantive prosecution on the merits until the Office Action mailed September 17, 2008. That is, there was no prior art applied to reject the claims or issues under 35 USC §112, first paragraph until the issuance of this Office Action.

In the Advisory Action, the Examiner asserted that the Office Action of September 17, 2009 was the second action on the merits and that the rejections in the Office Action of September 17, 2009 were due to the Applicant's amendments.

However, MPEP 706.07 sets forth:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied . . .

In this case, there was no search by the Examiner until the Office Action mailed September 17, 2008, as indicated by the appended PTO 892 form and a lack thereof in the preceding Office Actions. This PTO 892 form made of record the art references applied against the present invention in the Office Action of September 17, 2009.

Therefore, the holding of finality of September 17, 2008 was made before a clear issue could be developed between the Examiner and the applicant.

Also, the Examiner issued the Advisory Action less than a week short of the 6 month statutory date in response to an amendment timely filed 3 months after the issuance of the Office Action. As is set forth in MPEP 706.07(f): *"Replies after final should be processed and considered promptly by all Office personnel."* Although the Applicant is cognizant of the work load placed on Examiners, the delay in issuance of Advisory Action did not leave the Applicant (who is in Norway) sufficient time to consider the options for response.

The Application should thus be considered as under non-final rejection for both procedural and equitable reasons.

Please charge any petition fee to Deposit Account No. 25-0120.

The Commissioner is hereby authorized in this, concurrent, and future submissions, to charge any deficiency or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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